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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/721,880 | 11/27/2000 | James R. Henshaw | 107979 | 4029 |

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EXAMINER

GUADALUPE, YARITZA

ART UNIT PAPER NUMBER

2859

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,880

Applicant(s)

HENSHAW ET AL.

Examiner

Yaritza Guadalupe

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 11-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 7. 6) ☐ Other:

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed February 22, 2001 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.
2. The information disclosure statement filed February 22, 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 - 10, drawn to a measuring apparatus, classified in class 33, subclass 706.

Art Unit: 2859

II. Claims 11 - 13, drawn to a scale tensioning device, classified in class 248, subclass 575.

III. Claims 14 - 18, drawn to a method for tensioning a scale, classified in class 248, subclass 575.

The inventions are distinct, each from the other because of the following reasons:

4. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as ⁱⁿ a measuring apparatus ~~such as one~~ which does not require preloading to urge the scale into tension. See MPEP § 806.05(d).

5. Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as one which does not require tensioning the scale.

Art Unit: 2859

6. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as one which secure both ends of the scale to the substrate before tensioning.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. During a telephone conversation with Mr. David on March 19, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 - 10.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 11 - 18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1 – 2, 4 – 5 and 8 - 10 are rejected under 35 U.S.C. 102 (b) as being anticipated by Reilly (US 5,826,346).

Reilly discloses a measuring gage having an elongate track (12) for holding a measuring scale, the track having a channel / slot (58) wherein the track is adapted for attracting magnetically, by means of a magnetic material / strip (62) disposed on the channel / slot, a magnetisable scale (60) to the track (See Column 3, lines 56 – 62). Reilly discloses the track

Art Unit: 2859

being extruded (See Column 2, lines 65 – 66). Reilly discloses a scale tensioner (64, 66) for tensioning the scale on the track (See Columns 3 and 4, lines 65 – 67 and 1 – 7 respectively).

With respect to the term “ adapted for ” in claim 1 : Reilly discloses a track which is considered to be “ adapted for ” attracting magnetically the scale as stated in the claim.

Furthermore, the term “ adapted for ” makes what follows a functional statement and not a positive limitation because it has been held that the recitation that an element is “ adapted for ” perform a function only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

With respect to the term “ adapted to ” in claim 5 : Reilly discloses the channel which is considered to be “ adapted to ” hold the scale as stated in the claim. Furthermore, the term “adapted to” makes what follows a functional statement and not a positive limitation because it has been held that the recitation that an element is “ adapted to ” perform a function only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2859

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3, 6 and 7 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Reilly (US 5,826,346).

Reilly discloses a measuring gage as stated in paragraph 11 above.

Reilly does not disclose the ferrite rubber material as stated in claim 3. Reilly does not disclose the track made of aluminum as stated in claim 6. Reilly does not disclose the track made of magnetic ferrite rubber as stated in claim 7.

With respect to claim 3 : Reilly discloses a magnetic material / strip (62) but does not disclose the particular magnetic material / strip used. The use of the particular type of magnetic material claimed by applicant, i.e., ferrite rubber, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as a magnetic material is provided for securely attaching the scale into the channel, as already suggested by Reilly, 2) the magnetic material claimed by Applicant and the magnetic material used by Reilly are well known alternate types of magnetic materials which will perform the same function, if one is replaced with the other, of securely attaching the scale into the channel, and 3) the use of the particular type of magnetic material by

Art Unit: 2859

Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of magnetic material that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to securely attach the scale into the channel as already suggested by Reilly.

Regarding claims 6 – 7 : Reilly discloses a measuring gage but does not disclose the particular material used to make the track (12). The particular type of material used to make the track, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nelle et al. (US 6,163,970) discloses a device having a scale (2) connected to a track (6) by a magnetizable material (24) (See Column 8, lines 45 – 52). Spies (US 6,018,881) disclose a measuring system comprising a magnetic scale (1). Yatsu et al. (US 5,842,283) discloses an apparatus comprising a track rail (15), a scale (45) mounted on the

Art Unit: 2859

track. Suzuki et al. (US 6,119,359) discloses a measuring instrument comprising a scale (36) attached to the channel (44) of the track (34).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe whose telephone number is (703)305 -5676.

The examiner can normally be reached on 9:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7722 for regular communications and (703)308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.



Y. Guadalupe
March 21, 2002

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